

Atty Dkt. No.: CLON-107  
USSN:10/765,244

### **REMARKS**

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 30-50, the only claims pending and currently under examination in this application.

### ***Formal Matters***

Claims 1-29 have been cancelled without prejudice to renewal, and without intent to surrender any subject matter encompassed by the canceled claim. Applicants expressly reserve the right to pursue any canceled subject matter in one or more continuation and/or divisional applications.

Claims 30-50 have been added. Where not otherwise specified below, the added claims find their support in the original claims. Claim 30 has been added. Support for this amendment can be found in original Claims 1 and 10 and in the specification in Figure 2B as an exemplary location. Claims 32-41 have been added. Support for these claims can be found in the original claims, and support for the clarification that the construct described therein is a nucleic acid can be found in original Claim 2 and in the specification on page 9, lines 5-7. Claim 32 has been added. Support for this claim can be found in the specification on page 12, lines 5-8. Claim 33 has been added. Support for this claim can be found in the specification on page 13, line 8. Claim 34 has been added. Support for this claim can be found in the specification on page 11, lines 17-20. Claim 35 has been added. Support for this claim can be found in the specification on page 13 lines 3-6. Claim 41 has been added. Support for this claim can be found in the specification on page 10 lines 9-12. Claim 43 has been added. Support for this claim can be found in the original claims, and support for the clarification that the object of the original claim 8 is a cell or its progeny which contains the nucleic acid of Claim 30 can be found in the specification on page 22, lines 8-11. Claim 44 has been added. Support for this claim can be found in the specification on page 10, lines 3-12. Claim 45 has been added. Support for this claim can be found in the specification on page 9, lines 7 and 8. Claim 46 has been added. Support for these claims can be found in the

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specification on page 9, lines 5-7. Claim 47 has been added. Support for this claim can be found in the specification on page 10, lines 6-10. Claim 48 has been added. Support for this claim can be found in the specification on page 9, last line through page 10, lines 1 and 2, and page 21 lines 9-15 as exemplary locations. Claim 49 has been added. Support for this claim can be found in the specification on page 25, last paragraph through page 26, first paragraph. Claim 50 has been added. Support for this claim can be found in the specification on page 25, paragraph 2, page 26, paragraph 2 and page 27, lines 3-8.

As no new matter has been added by way of these amendments, entry thereof by the Examiner is respectfully requested.

#### ***Claim Objections***

Claims 9, 11, 12, 17, 20, 21, 25, 27-29 were objected to due to minor informalities. In view of the cancellation of these claims, these objections are moot.

#### ***Claim Rejections – 35 USC § 102***

The Examiner rejects Claims 1-18, 20, 21, and 24-29 under 35 U.S.C. § 102(e) as being anticipated by Lukyanov et al. The Applicants have cancelled Claims 1-29 and as such, these rejections are moot.

The new Claims 30-43 are directed to a nucleic acid which encodes a fusion protein that includes a reporter domain and a protein degradation domain, wherein the reporter domain is a reef coral protein and the fusion protein is at least 4 times more sensitive as a reporter of inhibition than a fusion protein that includes a d1 protein degradation domain.

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As such, an element of the claimed invention is a fusion protein which is at least 4 times more sensitive as a reporter of proteasome inhibition than a fusion protein that includes a d1 protein degradation domain, as shown in Figure 2B of the present application.

MPEP § 2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Lukyanov et al. does not teach the claimed sensitivity element.

Because Lukyanov et al. fails to teach each and every element of the claimed invention, the new claims are not anticipated by Lukyanov et al. under 35 U.S.C. § 102(e).

The Examiner rejects Claims 1-10, 12-18, 20, 21 and 24-29 under 35 U.S.C. § 102 (b) as being anticipated by Li et al. The Applicants have cancelled claims 1-29 and as such, these rejections are moot.

The Applicants submit that the new claims 30-42 and 53-55 are patentable over Li et al. because Li et al. does not teach the claimed reef coral fluorescent protein element or the claimed sensitivity element.

As such, Li et al., fails to teach each and every element of the claimed invention. Because Li et al. fails to teach each and every element of the claimed invention, the new claims are not anticipated by Li et al. under 35 U.S.C. § 102(b).

New claims 43-52 are patentable for at least the reasons provided above.

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**CONCLUSION**

In view of the amendments and remarks above, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number CLON-107.

Respectfully submitted,

BOZICEVIC, FIELD & FRANCIS LLP

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By: 

Bret E. Field  
Registration No. 37,620

BOZICEVIC, FIELD & FRANCIS LLP  
1900 University Avenue, Suite 200  
East Palo Alto, CA 94303  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231

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